

PATENT
Customer Number 22,852
Attorney Docket No. 07451.0005-01
InterTrust Ref. No.: IT-7.1 (US)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Karl L. GINTER et al.

Serial No.: 09/398,665

Filed: September 17, 1999

**For: TRUSTED INFRASTRUCTURE
SUPPORT SYSTEMS, METHODS
AND TECHNIQUES FOR SECURE
ELECTRONIC COMMERCE,
ELECTRONIC TRANSACTIONS,
COMMERCE PROCESS CONTROL
AND AUTOMATION, DISTRIBUTED
COMPUTING, AND RIGHTS
MANAGEMENT**

Group Art Unit: 2132

Examiner: G. Barron, Jr.

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Technology Center 2100

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

NOTICE REGARDING RELATED LITIGATION

Applicants hereby notify the U.S. Patent and Trademark Office that several patents assigned to InterTrust Technologies Corporation ("InterTrust") are involved in litigation. The present application, Serial No. 09/398,665, is a continuation of U.S. Application Serial No. 08/699,712, now abandoned, which is a continuation-in-part of U.S. Application Serial No. 08/388,107 (the '107 application), now abandoned. The '107 application is the parent of U.S. Patent Nos. 6,389,402 B1; 6,253,193 B1; 6,185,683 B1; 5,982,891; 5,949,876; 5,917,912; 5,915,019; and 5,892,900, which are at issue in the litigation.

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STATUS OF RELATED LITIGATION

The status of the litigation is as follows. On April 26, 2001, InterTrust filed a Complaint alleging that Microsoft Corporation ("Microsoft") was infringing U.S. Patent No. 6,185,683 B1, assigned to InterTrust. See *InterTrust Tech. Corp. v. Microsoft Corp.*, (C 01-1640 SBA, N. D. Ca.). A copy of the Complaint is attached as Exhibit A. On June 26, 2001 and July 26, 2001, InterTrust amended its complaint to add U.S. Patent Nos. 6,253,193 B1; 5,920,861; and 5,940,504.¹ See Exhibit B.

On August 29, 2001, Microsoft filed its Answer to InterTrust's Second Amended Complaint. See Exhibit C. On September 17, 2001, Microsoft filed a First Amended Answer and Counterclaims, asserting twelve affirmative defenses, including, *inter alia*, non-infringement, invalidity, dedication to the public, prosecution history estoppel, and inequitable conduct, and counterclaiming for declaratory judgments of non-infringement and invalidity of the InterTrust patents, and for infringement of U.S. Patent Nos. 6,049,671 and 6,256,668 B1, allegedly assigned to Microsoft. See Exhibit D.

On October 26, 2001, InterTrust filed a Third Amended Complaint to add U.S. Patent Nos. 5,917,912; 5,892,900; and 5,982,891. See Exhibit E. Microsoft filed its Answer and Counterclaims to InterTrust's Third Amended Complaint on November 8, 2001, see Exhibit F, and filed an Amended Answer and a "Corrected" Amended Answer on November 14 and 15, respectively, see Exhibits G and H, asserting several additional affirmative defenses and counterclaims. See, e.g., *id.* at pages 9 and 13-19.

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¹ The '504 patent was subsequently dismissed from this suit.

On February 6, 2002, InterTrust filed a second lawsuit against Microsoft, alleging infringement of U.S. Patent No. 6,157,721 ("the '721 patent"). See Exhibit I.² Microsoft filed its Answer and Counterclaims on March 25, 2002, and filed a First Amended Answer and Counterclaims on April 12, 2002, asserting thirteen affirmative defenses, including, *inter alia*, non-infringement, invalidity, dedication to the public, prosecution history estoppel, inequitable conduct, and unenforceability, and counterclaiming for declaratory judgment of non-infringement and invalidity. See Exhibit J. On June 5, 2002, Microsoft served its Initial Disclosures Pursuant to Fed. R. Civ. P. 26(a)(1), identifying various technologies believed by Microsoft to bear on the validity of the '721 patent. See Exhibit K.

On July 30, 2002, InterTrust filed a motion for leave to file a Fourth Amended Complaint, adding claims of infringement of additional InterTrust patents. This motion was granted on October 22, 2002. The Fourth Amended Complaint was filed on October 24, 2002, adding to the case claims of infringement of U.S. Patent Nos. 6,112,181; 5,915,019; 5,949,876; and 6,389,402 B1. See Exhibit L.

On August 16, 2002, Microsoft served its Preliminary Invalidity Contentions Regarding U.S. Patent Nos. 6,253,193 B1 and 6,185,683 B1 ("Preliminary Invalidity Contentions"). See Exhibit M. In its Preliminary Invalidity Contentions, Microsoft asserts that certain claims in those patents are indefinite, lack enablement, and lack an adequate written description. Microsoft also asserts that certain claims are anticipated or rendered obvious by various references. See *id.* at pages 3-7.

² This case has since been consolidated with the case filed April 26, 2001.

REMARKS

In support of its claim that InterTrust's U.S. Patent Nos. 5,892,900; 5,920,861; and 6,157,721 are unenforceable, Microsoft cites three references: (1) an article entitled DigiBox: A Self-Protecting Container for Information Commerce, by Olin Sibert et al. ("the Sibert article"); (2) PCT Publication No. WO 96/27155 ("the PCT Publication"); and (3) U.S. Patent No. 5,910,987 ("the '987 patent"). Applicants note that the Sibert article was cited in connection with the present application in an IDS filed November 13, 2001. Applicants also note that the PCT Publication is the international counterpart of the '107 application. This application is ultimately a continuation in part of the '107 application. The '987 patent is a continuation of the '107 application. In support of its Preliminary Invalidity Contentions for the 6,253,193 and 6,185,683 patents, Microsoft relies on a number of other documents. See Appendix to Preliminary Invalidity Contentions in Exhibit M.

If there are any fees due with the filing of this Notice not already accounted for, please charge the fees to our Deposit Account No. 06-0916

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
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Dated: November 20, 2002

By: 

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